REMARKS

Claims 1, 3, 5-6, 11-12, and 32-39 are currently pending. Claims 1 and 33 are the independent claims and are being amended. Support for the amendments is found throughout the specification, for example, at page 1, line 19-21; at page 3, lines 21-28; at page 4, lines 21-27; and at page 5, lines 9-13 and lines 26-28. No new subject matter is added. Applicant requests reconsideration of the pending claims in view of the amendments and the following remarks.

Examiner Interviews

Applicant thanks Examiner Silver for participating in the telephone interview on Tuesday, February 16. Participating in the interview on behalf of Applicant was the undersigned attorney Andrew Dommer. Applicant appreciated the opportunity to discuss the claims and the important advantages achieved from the claimed subject matter. Applicant discussed how the claims recite features that are not taught by Hoffberg et al. (Pat. No. 6,400,996). No agreement was reached, although the Examiner indicated, subject to further search and consideration, that Hoffberg, Fujiwara (Pub. No. 2002/0091875), and Davis (Pub. No. 2004/0034570) do not appear to teach some features of the independent claims. Applicant and Examiners discussed potential clarifying claim amendments and Applicant is making the claim amendments that were discussed.

The Examiner called Applicant on Friday, February 19 and suggested that Applicant consider Falcone et al. (Pub. No. 2002/0194096). Also, the Examiner suggested during the February 19 interview to amend the independent claims to recite an "unbroken" interactive session to clarify the subject matter of the claims over the pending references. The Examiner agreed that support for the claim amendment was found at page 5, lines 26-28. Applicant is amending the independent claims to recite an "unbroken" interactive session.

Claim Rejections – 35 U.S.C. § 103(a)

The Office Action (at page 2) rejected claims 1, 3, 5-6, 11, 32-37, and 39 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Fujiwara, in view of Davis, and further in view of Hoffberg (Pat. No. 6,400,996). The Office Action (at page 6) rejected claims 12 and 38 as being unpatentable over Fujiwara, in view of Davis, in view of Hoffberg, and further in view of Tamayo (U.S. Pub. No. 2002/0083067). Applicant respectfully submits that the pending claims are patentable over this proposed combination. Even if there was a reason that would have prompted a skilled artisan to combine Fujiwara and Davis (an issue that is not conceded herein), the proposed combination would nevertheless fail to provide the subject matter described in the pending independent claims.

Applicant notes that the Office Action appears to improperly perform a part-by-part analysis of the claims instead of determining whether the claimed invention as a whole would have been obvious to one of ordinary skill in the art at the time of invention. *See Ruiz v. A.B. Chance Company*, 357 F.3d 1270, 1275 (Fed. Cir. 2004) (providing that "section 103 specifically requires consideration of the claimed invention 'as a whole' . . . [and] the 'as a whole' instruction in title 35 prevents evaluation of the invention part by part"); *Custom Accessories v. Jeffrey-Allan Industries, Inc.*, 807 F.2d 955, 959-60 (Fed. Cir. 1986) (disclosing that "[c]asting an invention as 'a combination of old elements' leads improperly to an analysis of the claimed invention by the parts, not by the whole").

For instance, Ruiz provides the following example to illustrate the basis of the "as a whole" requirement:

> Without this important requirement [(the "as a whole" requirement)], an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. ***This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.***

Ruiz, 357 F.3d at 1275 (Fed. Cir. 2004) (emphasis added). Applicant respectfully submits that the present rejection is based on a hindsight reasoning using the claims as a roadmap, in analogy

with the practice that the Federal Circuit criticized in *Ruiz*. But even so, the references lack some features recited in the present independent claims.

Applicant respectfully submits that the prior art references fail to teach: (i) providing predictive information to a human user during an "unbroken online interactive session," (ii) "during the interactive session . . . performing the second prediction determination using both of the stored first state information generated as part of the first prediction determination and the second input value set," (iii) the electronic requests to the prediction computing engine each including information that was provided by the customer during the interactive session, and (iv) displaying during the course of the interactive session the first and second prediction results on a display device to the human user.

First, regarding independent claim 1, Fujiwara and Davis fail to disclose *"**providing predictive information to a human user during the course of conducting an unbroken online interactive session between the human user and a customer.**"* Indeed, the Office Action (at page 4) concedes that Fujiwara and Davis fail to disclose an "interactive session."

Hoffberg fails to provide that which Fujiwara and Davis are lacking. The Office Action (at page 6) directs Applicant to a description in Hoffberg of a "real time communication between [a] recipient and advertiser" that enables commercial information to be selectively presented to the customer. (Hoffberg, at col. 62, lines 28-31 and 49-54.) Hoffberg, however, fails to teach providing predictive information to the advertiser during the real time communication. Indeed, the recipient may "provide feedback for determining their preferences" and the advertiser may "present[] commercial information to the recipient based on characteristics individual to the recipient," (Hoffberg, at col. 62, lines 40-44 and 49-54), but Hoffberg fails to teach a system that provides predictive information to the advertiser.

In any event, even if Hoffberg's "real time communication" described the recited unbroken online interactive session (an issue Applicant contests), Hoffberg fails to remedy the failure of Fujiwara and Davis to teach the performance of particular claim limitations during a an unbroken online interactive session, as described below.

Second, regarding independent claim 1, Fujiwara and Davis fail to disclose *"during the interactive session . . . performing the second prediction determination using both of the stored first state information generated as part of the first prediction determination and the second input value set"* derived from the additional information about the customer that became available at the application system after the sending of the first request." Indeed, the Office Action (at page 4) concedes that Fujiwara and Davis fail to disclose the recited claim language.

Hoffberg fails to provide that which Fujiwara and Davis are lacking. The relied upon portion of Hoffberg teaches an "object identification method [for] classifying an object in an image, e.g., "car", "person", "house", etc." (Hoffberg, col. 142, lines 7-9.) Even if the disclosed object identification method described storing and using state information , the object identification is not performed "during the interactive session." Indeed, Hoffberg's object identification does not appear to be related to or performed during Hoffberg's real time communication. Further, and discussed below, the object identification method does not include the recited inputs to the recited "prediction determination" and does not display a "prediction result" to a human user.

Third, the combination of Fujiwara and Davis fail to disclose sending first and second requests to a prediction computing engine to perform respective first and second predictions, where the first and second requests include information that was provided by the customer during the interactive session. Specifically, Fujiwara and Davis fail to teach *"the first electronic request including a first input value set including information that was provided by the customer during the interactive session . . . [and] the additional information being provided by the customer during the interactive session."* Indeed, the Office Action (at page 4) concedes that Fujiwara and Davis fail to disclose an "interactive session," and thus do not disclose providing first and second requests that include information that was provided by the customer during an "interactive session."

Hoffberg fails to provide that which Fujiwara and Davis are lacking. The Office Action (at page 5) relies on "real time communication" between an advertiser and a customer as allegedly teaching the recited interactive session, and relies on object recognition as allegedly

teaching the recited prediction determination. The inputs to Hoffberg's object recognition algorithm, however, are not obtained from the customer during the real time communication. Indeed, the input to the object recognition algorithm is "raw image data" and Hoffberg provides no teaching or suggestion that this raw image data is provided by the customer at two different points in time during the interactive session. (Hoffberg, at col. 142, lines 11-13.)

In any event, the Examiner requested during the interview that Applicant explain why Fujiwara does not teach the recited inputs during an interactive session. As described in Applicant's June 10, 2009 response, Fujiwara describes a system where a data mining server receives a customer data from a database and uses the data to select customers to receive an advertisement email. (Fujiwara, at paragraphs [0151], [0172]-[0173], [0177]-[0178], and [0183].) Fujiwara's customer data is not received from the customers during an unbroken online interactive session, it is retrieved from a database and is used to determine which users should receive an email. (*Id.*)

Fourth, regarding independent claim 1, Fujiwara and Davis fail to disclose *"displaying during the course of the interactive session the first prediction result on a display device to the human user . . . and displaying during the course of the interactive session the second prediction result on a display device to the human user."* Indeed, the Office Action (at page 4) concedes that Fujiwara and Davis fail to disclose the recited interactive session, and therefore does not disclose displaying prediction results during the recited interactive session.

Tamayo fails to provide that which Fujiwara and Davis are lacking. Indeed, Hoffberg's object recognition algorithm does not generate a "prediction determination" that is displayed to a human user. To the contrary, the object recognition identifies objects in images.

Accordingly, the proposed combination of Fujiwara, Davis, and Hoffberg fails to achieve the subject matter described in independent claim 1. Applicant respectfully submits that claim 1 is patentable over Fujiwara, Davis, Hoffberg, and all other references in the record. Independent claim 33 recites language that is substantially similar to that in claim 1 and is patentable for at least the same reasons. Dependent claims 3, 5-6, 11-12, 32, and 34-39 are patentable for at least

the same reasons as their independent claims, and for the independently patentable features described therein.

Patentability of Pending Claims over Falcone et al. (Pub. No. 2002/0194096)

The Examiner suggested in the Friday, February 19 interview that Applicant consider the Falcone reference. Applicants submit that Falcone et al. (Pub. No. 2002/0194096) does not remedy the deficiencies of Fujiwara, Davis, Hoffberg, and that presently pending claims 1, 3, 5-6, 11-12, and 32-39 are patentable over Fujiwara, Davis, Hoffberg, Falcone, and all other references in the record.

Falcone describes a system that can "pre-screen credit applicants" of collect calls to determine if credit should be provided to the called parties. (Falcone, at paras. [0005]-[0006].) Falcone's collect-call credit determination system receives a telephone number of the individual that is called collect and generates an "initial customer score." (Falcone, at paras. [0012] and [0041]-[0042].) Then Falcone's system can "prompt the called party for additional, useful identification and validation information." (Falcone, at para. [0042].) "[T]he initial customer score is preferably refined into the refined customer score." (*Id.*) Based on the refined score, different credit products are either "present[ed] to the customer" or "automatically select[ed]" by the collect calling system for use by the customer. (Falcone, at para. [0044].)

First, regarding independent claim 1, Falcone fails to disclose "*providing predictive information to a human user during the course of conducting an unbroken online interactive session between the human user and a customer.*" To the contrary, Falcone describes a telephone call between Falcone's collect-calling system and the called party. Falcone's collect-calling system does not appear to provide predictive information to a human user. Indeed, Falcone's system appears to be automated as "the iDBS [intelligent direct billing system] . . . will select the appropriate variable billing cycle and/or variable payment cycle for the customer." (Falcone, at para. [0044].)

Second, regarding independent claim 1, Falcone fails to teach "*the first electronic request including a first input value set including information that was provided by the*

customer during the interactive session . . . [and] the additional information being provided by the customer during the interactive session." Indeed, Falcone's purported first electronic request is calculated by "access[ing] external databases" to find information based on the called party's telephone number. (Falcone, at paras. [0041]-[0042].) Only later is information gathered from the called party. (*Id.*)

Third, regarding independent claim 1, Falcone fails to disclose *"displaying during the course of the interactive session the first prediction result on a display device to the human user . . . and displaying during the course of the interactive session the second prediction result on a display device to the human user."* To the contrary, Falcone's system appears to be automated as "the iDBS [intelligent direct billing system] . . . will select the appropriate variable billing cycle and/or variable payment cycle for the customer." (Falcone, at para. [0044].) Falcone does not appear to display a first and second prediction result a human user. Indeed, Falcone appears to teach away from a system that displays a first and second prediction result to a human user. MPEP § 2141.02(VI); *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (explaining that a conclusion of nonobviousness is proper "when the prior art teaches away" from a claimed combination).

Accordingly, the Falcone fails to achieve the subject matter described in independent claim 1. Applicant respectfully submits that claim 1 is patentable over Fujiwara, Davis, Hoffberg, Falcone, and all other references in the record. Independent claim 33 recites language that is substantially similar to that in claim 1 and is patentable for at least the same reasons. Dependent claims 3, 5-6, 11-12, 32, and 34-39 are patentable for at least the same reasons as their independent claims, and for the independently patentable features described therein.

Conclusion

Applicants submit that claims 1, 3, 5-6, 11-12, and 32-39 are in condition for allowance, and request that the Examiner issue a notice of allowance.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or

concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

No fee is believed to be due. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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